

Serial No. 09/596,244**PATENT**

IBM Docket No. RAL919980012US1

REMARKS

This amendment is in response to the Office Action mailed September 20, 2004.

Claims 2-6 are allowed and will not be discussed further in this Amendment.

Claims 1 and 7 stand rejected and the rejection of these claims is addressed herein.

Claims 1 and 7 are rejected under 35 USC 103(a) as being unpatentable over Shand (U.S. Patent No. 6,147,976).

In response, applicants respectfully disagree with the rejection and argue that for reasons set forth herein claims 1 and 7 are patentable over Shand.

U.S. Patent No. 6,147,976 (Shand) discloses a filtering system that prevents unwanted packets from going to selected areas of a network. To perform the filtering the Shand reference provides code that uses rules from a rule database to generate filter table 80, address table 82, and protocol table 84, column 7, lines 61 through column 8, lines 1-45. When a packet arrives the logic in Shand extracts certain information from the packet, compare with material in selected one of the tables and based upon that comparison decides whether to discard a packet or allow it to pass through.

Applicants' claim 1 sets forth a technique (method) for generating a network subnet configuration. The method used in claim 1 is set forth in the above claim. Even though the claim as originally written captured the essence of applicants' invention in an attempt to promote the prosecution of this case "domain" is changed to "port". In other words, the "forwarding domain" referred to in the first act of claim 1 is now the --forwarding port --. It is believed that the claimed method is not used to establish any of the tables in the Shand

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reference. As a consequence, it is applicants' contention that the invention set forth in Shand is different from the invention claimed in claim 1. Because the invention in Shand is different from the invention claimed in claim 1, applicants contend Shand teaches away from applicants' claimed invention. It is settled law that where a reference teaches away from the claimed invention teaching from that reference cannot render the claimed invention obvious.

In addition, applicants argue the problem which applicants address is different from the problem in Shand et al. reference. In Shand the problem is to provide a new system for packet filtering which does not require a search through individual rules in a packet filtering database. See Shand column 2, lines 18-24. In contrast, applicants' problem is that of broadcast storms. (See applicants' specification, page 1, 2nd full paragraph.) It is applicants' contention that these problems are different, requiring different approach in order to provide satisfactory results. Because these problems are different, it is applicants' contention that an artisan viewing the Shand reference would not formulate a method that would render claim 1 obvious.

Applicants are mindful of the Examiner's attempt to identify elements in applicants' claim 1 with the Shand reference. But such an attempt appears futile and probably equivalent to someone trying to fit a square object in a round hole. For example, the Examiner admits that IP ARP frame --used by applicants to generate the table -- is not suggested in Shand et al., however, the Examiner states "it would have been obvious to a person of ordinary skill in the art at the time the invention was made Shand explicitly teaches IP ARP frames in the invention". Applicants are not sure what is meant by this statement. But in applicants' opinion it does not set forth sufficient logical reason why an artisan would associate an element that is absent in a patent, but is important to a claimed invention, with elements in the patent.

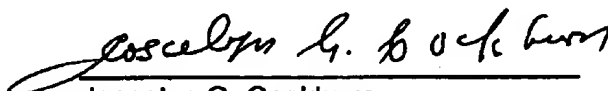
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Likewise, applicants' claim in part states "forwarding domain of the subnet". As to this element of the claim applicants change "domain" to "port". The Examiner in comparing this portion of applicants' claim relies on column 5, lines 1-10 of Shand et al. A review of this portion of Shand clearly indicates that it is not referring to forwarding domain, now forwarding port, as is claimed in applicants' invention. In essence, the Examiner attempts to equate elements in applicants' claim with the reference is in error. As a consequence, applicants contend that claim 1 is not obvious in view of the teachings of the reference. As to claim 7 it depends on claim 1 and is also patentable over the art of record for reasons set forth above.

It is believed that the present amendment answers all the issues raised by the Examiner. Reconsideration is hereby requested and an early allowance of all the claims is solicited.

Respectfully Submitted,



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